

REMARKS UNDER 37 CFR § 1.111

Formal Matters

Claims 1, 12-13, 46, 53, 58, 190-192 and 194-220 are pending after entry of the amendments set forth herein.

Claims 1, 12, 13, 46, 53, 58, 190-192 and 194-217 were examined. Claims 1, 12, 13, 46, 53, 58, 190-192 and 194-217 were rejected.

Applicants respectfully request reconsideration of the application in view of the amendments and remarks made herein.

No new matter has been added.

The Final Office Action and the Advisory Action

Claims Rejected Under Nonstatutory Double Patenting (U.S. Patent No. 6,743,169)

In the Official Action of October 4, 2007, claims 1, 12-13, 53, 58, 190-192, 194-214 and 216 were rejected on the ground of nonstatutory double patenting over claims 1-4, 6-13, 17, 20-26, and 31-32 of U.S. Patent No. 6,743,169, since the Examiner considered the currently claimed subject matter to be fully disclosed in the patent and covered by the patent since both the application and patent are claiming common subject matter, and the difference between the application claims and the patent claims is that the patent claims include more elements and are thus more specific.

In response to Applicants' assertion that a terminal disclaimer has already been filed in regard to this ground of rejection, the Examiner acknowledged that the terminal disclaimer has been received and is currently pending approval.

In view of the above comments and the terminal disclaimer which has already been filed, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 1, 12-13, 53, 58, 190-192, 194-214 and 216 on the ground of nonstatutory double patenting over claims 1-4, 6-13, 17, 20-26, and 31-32 of U.S. Patent No. 6,743,169 as being moot.

Claim Rejected Under Nonstatutory Obviousness-Type Double Patenting (U.S. Patent No. 6,743,169 in view of Vierra et al.)

Claim 46 was rejected on the ground of nonstatutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,743,169 in view of Vierra et al., U.S. Patent No. 5,749,892.

For at least the reasons provided above, Applicants do not agree with this ground of rejection and do not acquiesce thereto.

In view of the above comments and the terminal disclaimer which has already been filed, the Examiner is respectfully requested to reconsider and withdraw the rejection of claim 46 on the ground of nonstatutory obviousness-type double patenting over claim 1 of U.S. Patent No. 6,743,169 in view of Vierra et al., U.S. Patent No. 5,749,892, as being moot.

Claim Rejected Under 35 U.S.C. Section 102(b) (Green et al.)

Claims 214-217 were rejected under 35 U.S.C. Section 102(e) as being anticipated by Green et al., U.S. Patent No. 5,620,458. The Examiner asserted that Green et al. discloses a device 500 (Figs. 24-27) comprising a shaft member 540 and at least one continuously adjustable contact member comprising a wire 562 connected to the distal end of the shaft member. The Examiner referred to Figs. 24-25 and 27, and the specification at column 7, lines 60-62 as support for these assertions.

Applicants respectfully traversed this ground of rejection in an amendment (which has not been entered) filed June 10, 2008, noting that Green et al. discloses at column 7, lines 45-47 that arms 562 are formed by cutting a channel 563 in a sheet of resilient material.

In the Advisory Action dated August 4, 2008, the Examiner asserted that Applicants indicated that each of the contact members 562 is a sheet of material and not a wire. Applicants respectfully submit that the Examiner has misinterpreted Applicants' argument. Applicants did not argue that each of the contact members 562 is a sheet of material. Rather, a pair of the arms 562 are formed by cutting a slot 563 into a sheet of material, as clearly illustrated in Fig. 26 and as clearly described by Green et al. at column 7, lines 44-47 where Green et al. states; "Tissue spreading members 560 comprise two pairs of arms 562 formed by cutting a channel 563 in a sheet of resilient material. Accordingly, it is respectfully submitted that arms 562 are not wires, but only portions of the sheet of material, as they are integrated in the wider, proximal portion that does not include the slot 563, see Fig. 26.

Nevertheless, in an effort to advance the prosecution of the instant application, claim 214 has

been amended to recite that the wire is configured in a coiled configuration in an undeployed state.

Support for this amendment can be found, for example, at Figs. 21A-22C, the descriptions thereof, and throughout the specification.

Claim 215 has been amended to recite that the wire is round wire. Support for this amendment can be found, for example, at Figs. 6B and 21A-22C, the descriptions thereof, and throughout the specification.

In view of the above amendment and remarks, the Examiner is respectfully requested to reconsider and withdraw the rejection of claims 214-217 under 35 U.S.C. Section 102(e) as being anticipated by Green et al., U.S. Patent No. 5,620,458, as being inappropriate.

New Claims

New claims 218-220 have been submitted above. Support for claim 218 is found, for example, in claim 216, Figs. 21A-22C, the descriptions thereof, and throughout the specification. Support for claim 219 can be found, for example, at Figs. 6A-6B and 21A-22C, the descriptions thereof, and throughout the specification. Support for claim 220 can be found, for example, at Figs. 6A-6B, the descriptions thereof, and throughout the specification. The Examiner is respectfully requested to indicate the allowance of claims 218-220 in the next Official Action.


Conclusion

Applicants submit that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone the undersigned at the number provided.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-2653, order number GUID-005CON6.

Respectfully submitted,
LAW OFFICE OF ALAN W. CANNON

Date: 8/14/08

By: 
Alan W. Cannon
Registration No. 34,977

LAW OFFICE OF ALAN W. CANNON
942 Mesa Oak Court
Sunnyvale, CA 94086
Telephone: (408) 736-3554
Facsimile: (408) 736-3564